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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097219,935	12/23/98	BROWSE J	BB-1036-B

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LEGAL PATENT RECORDS CENTER
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WILMINGTON DE 19898

EXAMINER
MCLEWAIN, E

ART UNIT PAPER NUMBER
1649

DATE MAILED:

09/01/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/219,935

Applicant(s)

Browse

Examiner
Elizabeth McElwain

Group Art Unit
1649



☒ Responsive to communication(s) filed on Jun 8, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 and 20-28 is/are pending in the application.

Of the above, claim(s) 25 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 20-24, and 26-28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Applicant's election without traverse of Group I, claims 20-24 and 26-28 in Paper No. 5 is acknowledged.

It has now been noted that claim 1 also remains in the present application. Claim 1 is drawn to the elected invention, and therefore will also be examined.

5 Claims 1 and 20-28 are pending.

Claims 1, 20-24 and 26-28 are examined on the merits.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

10 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 20, and claims 21-24 and 26-28 dependent thereon are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15 Claim 1 is indefinite in the recitation of 50% identity with regard to a DNA sequence, given that determination of percent identity is dependent upon the particular algorithm and parameters used in the calculation, and no such algorithm and parameters have been set forth in the claim.

20 Claim 1 is also indefinite in the recitation of "desaturase-related", given that it is unclear what would be encompassed by this term.

Claim 20 is indefinite in that it refers to SEQ ID Nos 5, 7, 9, 11, 13 and 15 as nucleotide sequences. However, these SEQ ID Nos only set forth amino acid sequences.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5 Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 24 is drawn to seeds obtained from the plant of claim 23. However, there is no indication that the DNA construct transformed into the parent plant will be present in the claimed seeds. Given Mendelian inheritance only half of the seeds will comprise the introduced genetic construct, thus half of the seeds will be indistinguishable from
10 those which would occur in nature.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent
15 possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

20 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

25 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No.

08/244,205. Although the conflicting claims are not identical, they are not patentably distinct

from each other because the isolated nucleic acids having 50% identity or greater to SEQ ID Nos: 1, 4, 6, 8, 10, 12, 14 or 16 of the present claims would have been obvious over the sequences encoding the same enzyme activity and having the same SEQ ID Nos of the co-pending application 08/244,205.

5 This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

10 A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 20 is rejected under 35 U.S.C. 102(a) as being anticipated by Heinemann et al (sequence accession no. Q11851).

15 Heinemann et al teach a sequence of 22 nucleotides that is identical to a portion of the sequence of SEQ ID No: 1, for example.

No claims are allowed.

20 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (703) 308-1794. The examiner can normally be reached on Tuesday through Friday from 7:30 AM to 5:00 PM. The examiner can also be reached on alternate Mondays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (703) 308-3909. The fax phone number for this Group is (703) 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

10 August 26, 1999

ELIZABETH F. McELWAIN
PRIMARY EXAMINER
GROUP 1800

Elizabeth F. McElwain